

ADMINISTRATIVE PANEL DECISION

Columbia Insurance Company v. Name Redacted Case No. D2022-0528

1. The Parties

The Complainant is Columbia Insurance Company, United States of America (“United States”), represented by Baker & McKenzie LLP, United States.

The Respondent is Name Redacted.¹

2. The Domain Name and Registrar

The disputed domain name <berkshirehathawayrentals.com> is registered with Hosting Concepts B.V. d/b/a Registrar.eu (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 15, 2022. On February 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 17, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on February 17, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on February 18, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

¹ The Respondent appears to have used the name of an employee of the Complainant when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the Respondent's name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. D2009-1788.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 16, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 18, 2022.

The Center appointed Evan D. Brown as the sole panelist in this matter on March 28, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant's exclusive trademark licensee is in the business of providing a residential real estate brokerage franchise network. It owns the trademark BERKSHIRE HATHAWAY HOMESERVICES, which it has registered in several countries, including the United States (Reg. No. 4491859, registered on March 4, 2014).

According to the Whois records, the disputed domain name was registered on October 11, 2021. The Complainant alleges that the disputed domain name has been used by an unknown individual to fraudulently impersonate a legitimate Berkshire Hathaway HomeServices real estate agent, by creating and using an email address for commercial gain with the purpose of soliciting payment from unsuspecting consumers. The Respondent did not reply to cease and desist communications the Complainant sent concerning the disputed domain name.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name, and (iii) the disputed domain name has been registered and is being used in bad faith. The Panel finds that all three of these elements have been met in this case.

A. Identical or Confusingly Similar

This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and, second, whether the disputed domain name is identical or confusingly similar to that mark. This element under the Policy functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde*

Nast S.A. v. Voguechen, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the BERKSHIRE HATHAWAY HOMESERVICES mark by providing evidence of its trademark registrations.

It is standard practice when comparing a disputed domain name to a complainant's trademarks, to not take the Top-Level Domain into account. See [WIPO Overview 3.0](#), section 1.11.1 ("The applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.").

The disputed domain name incorporates the dominant portion of the BERKSHIRE HATHAWAY HOMESERVICES mark. This is sufficient for showing confusing similarity under the Policy.

The Panel finds that the Complainant has established this first element under the Policy.

B. Rights or Legitimate Interests

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. If the Complainant makes that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondent (with the burden of proof always remaining with the Complainant).

On this point, the Complainant asserts that the Respondent does not use the disputed domain name in connection with the *bona fide* offering of goods or services. Instead, the Respondent uses the disputed domain name to create the false impression that it is somehow related to or affiliated with the Complainant and/or the Complainant's licensee. According to the Complainant, an unknown individual began impersonating a legitimate Berkshire Hathaway HomeServices real estate agent, even using the agent's name. This imposter published sham Berkshire Hathaway HomeServices real estate listings using this fake persona, and began soliciting payment from unsuspecting Berkshire Hathaway HomeServices clients and other consumers using an email address under the disputed domain name. These communications and sham real estate postings included the disputed domain name as part of the sender's email address.

Additionally, the Complainant asserts that: (1) it has not authorized the Respondent to use the Complainant's trademark in the disputed domain name, (2) use of the Complainant's trademark in the disputed domain name is not a noncommercial or fair use, and (3) the Respondent has not been known by the Complainant's trademark.

The Panel finds that the Complainant has made the required *prima facie* showing. The Respondent has not presented any evidence to overcome this *prima facie* showing. Nothing in the present record otherwise tilts the balance in the Respondent's favor.

Furthermore, the nature of the disputed domain name, incorporating the Complainant's widely known trademark and a term related to the Complainant's area of business, carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, the Panel finds that the Complainant has established this second element under the Policy.

C. Registered and Used in Bad Faith

The Policy requires a complainant to establish that the disputed domain name was registered and is being used in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a respondent's bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent "[uses] the domain name to intentionally attempt to attract, for commercial gain, Internet users to [respondent's] website or other online location, by creating a likelihood of confusion with complainant's mark as to the source, sponsorship, affiliation, or endorsement of [respondent's] website or location or a product or

service on [the respondent's] website or location”.

Because the Complainant's marks are well-known, it is implausible to believe that the Respondent was not aware of those marks when it registered the disputed domain name. In the circumstances of this case, such a showing is sufficient to establish bad faith registration of the disputed domain name. Bad faith use is clear from the Respondent's activities of using the disputed domain name to send fraudulent email.

The lack of response by the Respondent to the cease-and-desist letter sent by the Complainant supports a finding of bad faith. Past UDRP panels have held that failure to respond to a cease-and-desist letter may be considered a factor in finding bad faith registration and use of a domain name. See *Encyclopaedia Britannica, Inc. v. John Zuccarini and The Cupcake Patrol a/k/a Country Walk a/k/a Cupcake Party*, WIPO Case No. [D2000-0330](#).

For these reasons, the Panel finds that the Complainant has successfully met this third UDRP element.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <berkshirehathawayrentals.com> be transferred to the Complainant.

/Evan D. Brown/

Evan D. Brown

Sole Panelist

Date: April 14, 2022